

Remarks

Applicant respectfully traverses the assertion that Applicant's reply filed on August 11, 2003, fails to comply with 37 C.F.R. § 1.111(c) because 37 C.F.R. § 1.111(c) is inapplicable. While the Examiner attempts to rely on § 1.111(c) this section applies only to a situation where an amendment to the application is presented. The August 11<sup>th</sup> reply did not include an amendment to any portion of the application: claims, drawings or Specification. Thus, the requirements of 37 C.F.R. § 1.111(c) are inapplicable to Applicant's previous response and the assertion that the August 11<sup>th</sup> reply was non-responsive in view thereof is improper. Accordingly, Applicant requests that the non-responsive holding be withdrawn.

Applicant respectfully submits that the arguments made in the Amendment filed on August 11, 2003, were responsive and compliant with 37 C.F.R. § 1.111(b). Section 1.111(b) requires Applicant to present arguments as to the patentability of the application over "any *applied* references." Applicant contends that no references were *applied* to the instant claims in the Office Action dated May 12, 2003. The May 12<sup>th</sup> Office Action merely reprinted Applicant's claims 1-10 and generally asserted that each of five references taught the claimed subject matter. There was no application of any specific teachings in the references to the instant claims.

To properly *apply* references, the Office Action must comply with, among other statutes and regulations, 35 U.S.C. § 132. Section 132 requires that the Examiner state the reasons for any rejections together with such information and references as may be useful in judging the propriety of continuing prosecution of the application. The May 12<sup>th</sup> Office Action provided no explanation as to how the cited references allegedly correspond to the claimed invention. The Examiner failed to provide any rationale in support of the rejections or identify teachings in the cited references that correspond to the claimed invention.

The Office Action also incorrectly relies on the MPEP definition of a *prima facie* case of rejection as being "established when the information compels a conclusion that a claim is unpatentable ...." Thus, the rejection would be established as a result of "information" set forth by the Examiner. The May 12<sup>th</sup> Office Action did not contain any information that would satisfy this MPEP requirement. Moreover, MPEP § 707.07(d) requires that when a claim is rejected, the ground of rejection should be "fully and clearly stated." No grounds of rejection or rationale were presented in the May 12<sup>th</sup> Office Action.

The arguments presented specifically pointed out that the Office Action failed to present a *prima facie* case of rejection under 35 U.S.C. § 102 because the Office Action failed to present any correspondence between the teachings of the cited references and each of the claimed limitations. In order to establish a *prima facie* case of anticipation, MPEP § 2131 specifically requires that each and every element as set forth in the claims must be found in a single reference. Applicant cannot determine from the May 12<sup>th</sup> Office Action where the cited references allegedly teach each of the claimed limitations, and the Office Action fails to identify any evidence that would show this correspondence; therefore, Applicant has no obligation to speculate as to the Examiner's beliefs and then to rebut Applicant's speculation.

As none of the generally asserted references were applied to the instant claims, Applicant was not obligated to address the specific references. Accordingly, Applicant requests that the non-responsive holding be withdrawn.

Applicant further submits that if the application were to be appealed at this time, the appeal rules would prohibit the Examiner from presenting any basis or rationale to explain any alleged correspondence between these generally-cited references and Appellant's claimed invention. Any such basis or rationale would be first presented in the Examiner's Answer, and they would therefore be new grounds of rejection. New grounds of rejection are not permissible. *See* 37 C.F.R. § 1.193(2).

Notwithstanding the above traversal, a review of the cited references indicates that the cited references fail to teach the claimed invention. For example, none of the references appear to teach limitations directed to the claimed graphic display set forth, for example, in claim 1. At least the '376, '497, and '789 references fail to discuss the claim limitations directed to the series of scan flops, and none of the figures of the cited references appears to correspond to Applicant's claim-supporting figures. Thus, Applicant maintains the previously presented traversal of each of the Section 102 rejections because the Office Action fails to present a *prima facie* Section 102 rejection.

With respect to claim 2, Applicant respectfully traverses the rejection because the Office Action fails to assert that any reference teaches the claimed limitations. No references have been cited in connection with the rejection and thus the rejection is improper. Applicant accordingly requests that the rejection be withdrawn.

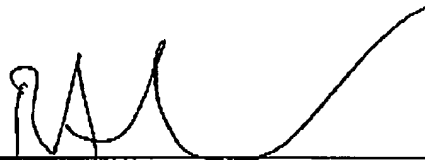
Moreover, Applicant respectfully disagrees with the characterization, at page 6, of the U.S. patents listed in the Examiner's Notice of References Cited. Applicant notes, however, that none of the patents is relied upon.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Mr. Peter Zawilski, of Philips Corporation at (408) 474-9063.

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